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| APPLICATION NO.                                                                                        | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/086,557                                                                                             | 02/28/2002  | Samuel W. Ho         | 57243-5007          | 5091             |
| 24574                                                                                                  | 7590        | 11/03/2006           | EXAMINER            |                  |
| JEFFER, MANGELS, BUTLER & MARMARO, LLP<br>1900 AVENUE OF THE STARS, 7TH FLOOR<br>LOS ANGELES, CA 90067 |             |                      | LE, LINH GIANG      |                  |
|                                                                                                        |             | ART UNIT             | PAPER NUMBER        |                  |
|                                                                                                        |             | 3626                 |                     |                  |

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                           |                     |
|------------------------------|---------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b>    | <b>Applicant(s)</b> |
|                              | 10/086,557                | HO, SAMUEL W.       |
|                              | Examiner<br>Linh-Giang Le | Art Unit<br>3626    |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 August 2006.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-55 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-55 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____                                                         | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the amendment filed on 8/16/06. Claims 1-55 are pending.

***Claim Rejections - 35 USC § 101***

2. The rejection of claims 1-30 under 35 USC 101 is hereby withdrawn.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-30 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood (5,706,441) in view of Pack-Harris (6,195,612) for the same reasons as stated in the previous Office Action.

5. New claims 31, 32-41, 42-47, 48-50, 51, 52, 53, 54, and 55 repeat limitations of claims 1-30 and the reasons for rejection are incorporated herein.

***Response to Arguments***

6. Applicant's arguments filed 8/16/06 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response field 8/16/06.

(A) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(B) Applicant argues that because Lockwood is used by health-care networks to more efficiently oversee the operation of the health care network it teaches away from the use of the method as a quality rating tool for selection of a health care provider by a health care consumer. In response, Examiner points out that the claim language describes *only* a "quality rating tool." It is not specified *who* will use the "quality rating tool." Thus, even if an administrator of the network uses the "quality rating tool" of Lockwood, it does not necessarily imply his or her motives are not aligned with a health care consumer as Applicant suggests.

(C) Applicant next argues Pack-Harris does not teach or suggest creation of a "quality rating tool" and in combination with Lockwood only creates a system that assists medical service providers in saving costs and enhancing their "bottom line." Applicant

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cannot show non-obviousness by attacking the Pack-Harris reference individually when the rejection is based on Lockwood in view of Pack-Harris. Examiner utilizes the Pack-Harris reference to teach the feature of monitoring prescription utilization information. Furthermore, the claim language does not specify how the “quality rating tool” can be used. The claim language in independent claim 1 describes using the tool to select an entity but does not specify what the criteria is based on.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

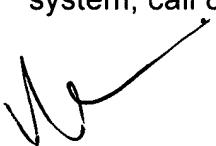
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linh-Giang Le whose telephone number is 571-272-8207. The examiner can normally be reached on 8 AM - 5PM, M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-3600. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



LLe



C. LUKE GILLIGAN  
PATENT EXAMINER